

5/20/08 #36

PATENT
New Docket No. 0465-1984PUS1
Old Docket No. 1630-0515PUS1

IN THE U.S. PATENT AND TRADEMARK OFFICE

APPLICANT: Je H. LEE et al.
APPLICATION NO.: 09/118,824
(Subsequently reissued as U.S. RE38,868 on
November 8, 2005)
(Reissue of U.S. Patent No. 5,587,789, which issued on
December 24, 1996)
FILED: July 20, 1998
FOR: APPARATUS AND METHOD FOR CONTROLLING
RECORDING AND REPRODUCTION IN DIGITAL
VIDEO CASSETTE TAPE RECORDER
ART UNIT: 2615
EXAMINER: Thai Tran

Mail Stop Petition
Commissioner For Patents
P.O. Box 1450

Alexandria, Virginia 22313-1450

May 20, 2008

**PETITION UNDER 37 C.F.R. §§ 1.67 AND 1.182 TO PLACE
SUPPLEMENTAL DECLARATION AND SWORN STATEMENT IN FILE**

Sir:

Pursuant to 37 C.F.R. §§ 1.67 and 1.182, patentees and their assignee (hereafter, "Petitioners") hereby petition that the Second Supplemental Declaration of Jehyoung Lee and the Supplemental Sworn Statement of Dae Sul Shim be placed in the file of U.S. RE38,868 ("the '868 Reissue Patent"), which reissued on November 8, 2005 from U.S. reissue application 09/118,824 ("the '824 Reissue Application").

If, for some reason, the Petition under 37 C.F.R. § 1.182 is dismissed or not granted, please treat this as a Petition pursuant to 37 C.F.R. § 1.183, wherein Petitioners hereby petition that the Second Supplemental Declaration of Jehyoung Lee and the Supplemental Sworn Statement of Dae Sul Shim be placed in the file of the '868 Reissue Patent.

Petitioners currently have another Petition Under 37 C.F.R. §§ 1.67 and 1.182 To Place Supplemental Declarations And Sworn Statements In File pending before the U.S. Patent and Trademark Office ("U.S.P.T.O."), which was filed on March 17, 2008. That petition also concerns the '868 Reissue patent.

By this Petition, Petitioners seek to submit the above-referenced Second Supplemental Declaration of Jehyoung Lee, one of the co-inventors of the '868 Reissue Patent, because Quanta Computer Inc. and Quanta Computer USA, Inc., defendants in *LG Electronics v. Quanta Computer Inc., et. al.*, Civ. Action No. 07-C-0361, a case pending in the Western District of Wisconsin in which the '868 Reissue Patent is a patent-in-suit, assert that Mr. Lee did not properly "review" the '824 Reissue Application at the time he authorized his signature on the Combined Reissue Declaration and Power of Attorney for the '824 Reissue Application (the "Reissue Declaration"). However, even though Mr. Lee did not physically review the '824 Reissue Application, Mr. Lee nonetheless understood and approved the content of the '824 Reissue Application at the time he authorized his signature, and he believed in good faith that he had a sufficient understanding of the '824 Reissue Application

to authorize that the Reissue Declaration be signed on his behalf. The Second Supplemental Declaration of Mr. Lee indicates that such procedure was undertaken by Mr. Lee in good faith and without any intent to deceive the U.S.P.T.O.

Petitioners also seek to submit the above-referenced Supplemental Sworn Statement of Dae Sul Shim, who was the employee of the assignee involved in the preparation and filing of materials related to the '824 Reissue Application, and who received authorization by Mr. Lee to sign the Reissue declaration on Mr. Lee's behalf. The Supplemental Sworn Statement of Mr. Shim indicates that Mr. Shim believed in good faith that Mr. Lee had sufficiently "reviewed and underst[ood] the contents of the ['824] reissue application including original claims 1-22 and newly submitted claims 23-58," as stated in the Reissue Declaration, and Mr. Shim did not intend to deceive the U.S.P.T.O. at the time that Mr. Shim had Mr. Lee's name applied to the Reissue Declaration on Mr. Lee's behalf.

The Second Supplemental Declaration of Jehyoung Lee and Supplemental Sworn Statement of Dae Sul Shim set forth the facts and circumstances in which the Reissue Declaration was understood and approved by Mr. Lee, and Petitioners, in an observance of good faith and candor, petition to have the Second Supplemental Declaration and Sworn Statement placed in the '868 Reissue Patent file wrapper.

Although there are no regulations or provisions specifically directed to the filing of supplemental declarations and sworn statements of the type attached hereto, Petitioners respectfully note that a similar petition was filed with the U.S.P.T.O.

under the facts set forth in *Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1344 (Fed. Cir. 2000), and that procedure was acknowledged by the U.S. Court of Appeals for the Federal Circuit in that case.¹ In *Ajinomoto*, the patentee discovered during litigation that not all of the inventors personally signed declarations that were submitted during prosecution. *See id.* Instead, some of the inventors authorized others to sign on their behalf. *See id.* Upon this discovery, the patentee filed with the U.S.P.T.O. a supplemental declaration that contained the true signatures of the inventors, along with a petition to the Commissioner of Patents and Trademarks pursuant 37 C.F.R. §§ 1.67 and 1.182 requesting that the U.S.P.T.O. place the supplemental declaration in the patent's file wrapper. *See Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 1998 U.S. Dist. LEXIS 3833 at 24 (D. Del. 1998). In affirming the district court's finding that the patent-in-suit was valid, the Federal Circuit took into consideration the patentee's supplemental declaration, which stated that the procedure followed for the prior declarations, wherein some of the inventors authorized others to sign on their behalf, "was the result of a lack of knowledge of the technical requirements of U.S. patent law and was made without deceptive intent." *See Ajinomoto*, 228 F.3d at 1344. Petitioners seek to utilize procedures similar to those used by the applicant in *Ajinomoto*.

¹ Petitioners take this opportunity to rectify the statement made in its March 17, 2008 Petition that the petition filed in the *Ajinomoto* case "was granted" by the U.S.P.T.O. Even though the Federal Circuit relied on statements made in the submitted declarations to conclude that the patent-in-suit was valid, the Court did not mention the disposition of the petition enclosing the declarations, and, at this time, Petitioners are unable to confirm whether that petition was granted by the U.S.P.T.O. *Ajinomoto*, 228 F.3d 1344.

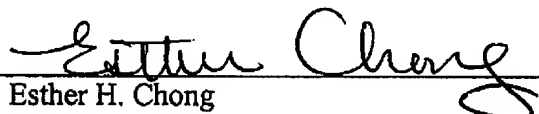
This Petition is accompanied by:

- (1) The Supplemental Declaration of Jehyoung Lee, dated May 15, 2008;
- (2) The Supplemental Sworn Statement of Dae Sul Shim, dated May 15, 2008;
- (3) Authorization to charge \$400.00 to Deposit Account No. 022448 in payment of the petition fee set forth in 37 C.F.R. § 1.17(f). The Director is also authorized to charge any other fees that may be required, or credit any overpayment to Deposit Account No. 022448.

Accordingly, Petitioners respectfully request that this Petition be granted and the above-identified Supplemental Declaration and Supplemental Sworn Statement be placed in the file of the '868 Reissue Patent. Early and favorable consideration of this Petition is respectfully requested. Please contact the undersigned at the telephone number below for any outstanding matters.

May 20, 2008

Respectfully submitted,



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